



IPD

Atty. Dkt. No. 034536-1150

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Peng Cho TANG et al.

Title: INDOLINONE COMBINATORIAL LIBRARIES AND RELATED  
PRODUCTS AND METHODS FOR THE TREATMENT OF DISEASE

Appl. No.: 10/784,917

Filing Date: 02/24/2004

Examiner: Stockton, Laura

Art Unit: 1626

**INFORMATION DISCLOSURE STATEMENT**  
**UNDER 37 CFR §1.56**

Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith on Form PTO/SB/08 is a listing of documents known to Applicants in order to comply with Applicants' duty of disclosure pursuant to 37 CFR §1.56.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicants do not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a *prima facie* art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The listed documents were first submitted in compliance with 37 CFR §1.97(b), along with the present divisional application filing.

As noted in the Office Action of October 12, 2005, the Examiner did not consider several of the references because copies were not found in the prior application(s), or the reference copies were illegible.

Applicants are attempting to obtain copies of Documents C10 and C20 will submit them upon receipt. It is noted that abstracts of Documents C7 and C25 have previously been considered by the Examiner.

Applicants respectfully request that the listed documents, with the exception of those listed but not enclosed ("n/a" appears in Examiner's Initials column) be considered by the Examiner and be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

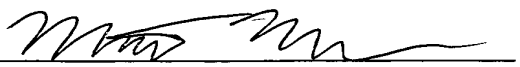
The absence of English translations does not relieve the PTO from its duty to consider any submitted document (37 CFR §1.98 and MPEP §609).

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date January 12, 2006

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5475  
Facsimile: (202) 672-5399

By   
for Matthew Mulkeen 44,250  
Beth A. Burrous  
Attorney for Applicant  
Registration No. 35,087

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449B/PTO				<b>Complete if Known</b>		
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>				<b>Prior Application Number</b>	10/784,917	
Date Submitted: January 12, 2006				<b>Prior Appl. Filing Date</b>	02/24/2004	
(use as many sheets as necessary)				<b>First Named Inventor</b>	Peng Cho TANG	
				<b>Group Art Unit</b>	1626	
				<b>Examiner Name</b>	Stockton, Laura	
Sheet	1	of	3	<b>Attorney Docket Number</b>	034536-1150	

FOREIGN PATENT DOCUMENTS								
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Documents	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
	C1	AU	286870		IMPERIAL CHEMICAL INDUSTRIES OF AUSTRALIA AND NEW ZEALAND LIMITED	05-11-1967		
	C2	CA	2,012,634	A1	UNIVERSITY OF BRITISH COLUMBIA	09-20-1991		
	C3	HU	65452		RICHTER GEDEON BEGYESZETI GYAR RT	06-28-1994		
	C4	WO	92/03736	A1	SEIKAGAKU KOGYO KABUSHIKI KAISHA	03-05-1992		
	C5	WO	94/10202	A1	GENENTECH, INC.	05-11-1994		
	C6	WO	96/32380	A1	PHARMACIA S.P.A.	10-17-1996		

NON PATENT LITERATURE DOCUMENTS				
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>6</sup>	
	C7	Andreani et al., "Synthesis and cardiotoxic activity of 2-indolinones," <u>Eur. J. Med. Chem.</u> 25:187-190 (1990) <i>(Abstract considered by examiner, best available full reference attached)</i>		
	C8	Andreani et al., "Synthesis and potential coanthracyclenic activity of substituted 3-(5-imidazo [2, 1-b]thiazolymethylene)-2-indolinones," <u>Eur. J. Med. Chem.</u> 32:919-924 (1997)		
	C9	Baserga, "Oncogenes and the strategy of growth factors," <u>Cell</u> 79:927-930 (1994)		
n/a	C10	Beilstein Reg. No. 233511 (1997)		

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

<sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449B/PTO				<b>Complete if Known</b>	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  Date Submitted: January 12, 2006  (use as many sheets as necessary)				Prior Application Number	10/784,917
				Prior Appl. Filing Date	02/24/2004
				First Named Inventor	Peng Cho TANG
				Group Art Unit	1626
				Examiner Name	Stockton, Laura
Sheet	2	of	3	Attorney Docket Number	034536-1150

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>6</sup>
	C11	Borsche et al., "Über nielkernige kondensierte systeme mit heterocyclischen ringen," <u>Liebigs Ann. Chem.</u> 550:160-174 (1941)	
	C12	Coda et al., "(Z)- and (E)-Arylidene-1,3-dihydroindol-2-ones: Configuration, Conformation and Infrared Carbonyl Stretching Frequencies," <u>Chemical Abstracts</u> , Vol. 101, abstract no. 37875 (1984)	
	C13	Daisley, "Thin-layer chromatographic separation of some substituted 3-benzylidene-indol-2(3H)-ones," <u>Chemical Abstracts</u> Vol. 82, abstract no. 72891 (1975)	
	C14	Houben-Weyl., "Substance Index," <u>Cyclic Compounds V Bicyclic Compounds 1</u> E231:834-1018 (1999)	
	C15	Howard et al., "Synthesis and aldose reductase inhibitory activity of substituted 2(1H)-benzimidazolone- and oxindole-1 acetic acids" <u>Chemical Abstracts</u> , Vol. 118, abstract no. 254813 (1993)	
	C16	Nodiff et al., "Antimalarial Phenanthrene Amino Alcohols. 1. Fluorine-Containing 3- and 6-Substituted 9-Phenanthrenemethanols," <u>Chemical Abstracts</u> , Vol. 76, abstract no. 21121 (1972)	
	C17	Schindler et al., "Dibenz[b,f]-azocin-Derivate," <u>Helvetica Chimica Acta</u> 49:985-989 (1966)	
	C18	Stetinova et al., "Stereochemistry and Photoisomerisation of Furfurylideneoxindoles," <u>Collection Czechoslov. Chem. Commun.</u> 42:2201-2206 (1976)	

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

<sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449B/PTO		<b>Complete if Known</b>	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  Date Submitted: January 12, 2006 <i>(use as many sheets as necessary)</i>		Prior Application Number	10/784,917
		Prior Appl. Filing Date	02/24/2004
		First Named Inventor	Peng Cho TANG
		Group Art Unit	1626
		Examiner Name	Stockton, Laura
Sheet	3	of	3
		Attorney Docket Number	034536-1150

## NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>6</sup>
	C19	Sumpter and Miller, "Chapter IV – Oxindole," in <u>Heterocyclic Compounds With Indole and Carbazole Systems</u> , Interscience Publishers, Inc., New York, pp. 134-153 (1954)	
n/a	C20	von Dobeneck et al., " $\alpha, \beta$ '-Diindolylmethane und-methene. Der Urorosein-Chromophor," <u>Zur Chemie des Indols</u> VI:1347-1357 (1969)	
	C21	Wahl, Beilstein Reg. No. 191439, <u>Bull. Soc. Chim. Fr.</u> , page 1038 (1909)	
	C22	Wahl, <u>Bull. Soc. Chim. Fr.</u> , pages 1035-1038 (1909) ( <i>see C21, partial duplicate</i> )	
	C23	Winkelmann et al., "Chemotherapeutically Active Nitro Compounds: 4. 5-Nitroimidazoles (Part I)," <u>Arzneim.-Forsch./Drug Res.</u> 27(II):2251-2263 (1977)	
	C24	Wright, Beilstein Reg. No. 235900, <u>J. Amer. Chem. Soc.</u> 78:221-224 (1956)	
	C25	Zhungietu et al., "Reaction of Indoles and 2-Ketoindolines With Some Aldehydes," <u>Institute of Chemistry, Academy of Science of the Moldavian SSR, Kishinev</u> pp. 34-37 translated from <u>Khimiya Geterotsiklicheskikh Soedinenii</u> 1:40-44 (1973) ( <i>Abstract considered by examiner, full document enclosed, not in English</i> )	

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

<sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.